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## REMARKS:

### Claim Rejection – 35 USC § 103

The OA rejected claims 25-32, 34-43, and 45 as being unpatentable over Bier (US Patent Publication No. 20040261023) in view of Dooley (US Patent Publication No. 20020035611). The OA rejected claims 33, 44, and 46-63 as being unpatentable over Bier in view of Dooley, in further view of Feeley (US Patent Publication No. 20040068460). Applicant respectfully traverses this rejection.

#### MPEP 2143 Basic Requirements of a Prima Facie Case of Obviousness

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

## I. IT WOULD NOT HAVE BEEN OBVIOUS TO COMBINE BIER AND DOOLEY

### A. Bier is Nonanalogous Art

The OA on page 3 states:

Bier and Dooley are analogous art because they are from the same field of the organization of information on the Internet. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Dooley's teachings into the Bier system. A skilled artisan would have been motivated to combine as suggested by Dooley at [0010], in order to provide an information network on the Internet, wherein the information, products, and services of a website will be accessed in order to provide value to the website owner. As a result, obtaining high volume traffic at the least cost per visitor.

The present invention, as stated in the title, is related to a *Method for Improving a Web site's Ranking with Search Engines*. Bier, in contrast, teaches "a server-based software tool that allows group-writable web pages to be created and customized" [Bier, 0008]. The present invention and Bier have very different purposes and solve very different problems. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem

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with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

**MPEP 2141.01(a)**

**V. ANALOGY IN THE ELECTRICAL ARTS**

See, for example, *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993) (Patent claims were directed to single in-line memory modules (SIMMs) for installation on a printed circuit motherboard for use in personal computers. Reference to a SIMM for an industrial controller was not necessarily in the same field of endeavor as the claimed subject matter merely because it related to memories. Reference was found to be in a different field of endeavor because it involved memory circuits in which modules of varying sizes may be added or replaced, whereas the claimed invention involved compact modular memories. Furthermore, since memory modules of the claims at issue were intended for personal computers and used dynamic random-access-memories, whereas reference SIMM was developed for use in large industrial machine controllers and only taught the use of static random-access-memories or read-only-memories, the finding that the reference was nonanalogous was supported by substantial evidence.); *Medtronic, Inc. v. Cardiac Pacemakers*, 721 F.2d 1563, 220 USPQ 97 (Fed. Cir. 1983) (Patent claims were drawn to a cardiac pacemaker which comprised, among other components, a runaway inhibitor means for preventing a pacemaker malfunction from causing pulses to be applied at too high a frequency rate. Two references disclosed circuits used in high power, high frequency devices which inhibited the runaway of pulses from a pulse source. The court held that one of ordinary skill in the pacemaker designer art faced with a rate-limiting problem would look to the solutions of others faced with rate limiting problems, and therefore the references were in an analogous art.). (emphasis added)

Applicant respectfully submits that *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993) described above is on point and dictates a finding that Bier is nonanalogous art with the present invention. The *Wang* court's reasoning applies with even greater force in the present case. The OA's stated field of endeavor is "organization of information on the Internet." The fact that the OA had to select such an unduly broad field of endeavor to encompass the invention, Dooley and Bier is a clear signal that one or more of the references are not analogous art with the invention. In *Wang* the fact that the invention and reference both related to the broad field of "memories" (and even the narrower field of SIMMs) was found insufficient by the *Wang* court since it did not take into account the differences in the claimed and referenced memories.

The differences between the present invention and Bier are much greater than the differences in the memories discussed in *Wang*. Specifically, the claimed invention has the purpose of improving a Web site's ranking with a search engine while Bier has the purpose of automatically making group-writable Web pages. A thread of similarity between the invention and

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Bier (though not found in Dooley) is that they both automatically modify Web site code, although for very different purposes. This similarity between the invention and Bier is even narrower than the similarity between the memories which the *Wang* decision found to be insufficient to make the reference memory analogous art. Bottom line, there is no teaching or suggestion in Bier that Bier's method of modifying Web site code would improve a Web site's ranking with a search engine or even increase the traffic to the Web site. Thus, Bier is not in the same field of endeavor with the invention and is nonanalogous art and should not be used as part of an obviousness rejection.

In addition, even though the OA's stated field of endeavor of "organization of information on the Internet" is improperly overly broad, Bier still does not fit within the OA's defined field as Bier is directed at automatically making group-writeable Web pages. While Web pages are certainly an important part of the Internet, "organization of information" on the scale of a Web page, as is done in Bier, uses totally different techniques when compared against "organization of information" on the scale of the Internet (requiring, for example, search engines). There is nothing in Bier to suggest any "organization of information" outside of what is done within a Web page. Thus, Bier does not even fall within the field of endeavor as defined by the OA, i.e. "organization of information on the Internet", and is therefore nonanalogous art and should not be used as a reference in an obviousness rejection.

**B. The Proposed Modifications to Bier would render Bier unsatisfactory for its Intended Purpose**

**MPEP 2143.01 Suggestion or Motivation To Modify the References [R-5]**

**V. THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE**

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (Claimed device was a blood filter assembly for use during medical procedures wherein both the inlet and outlet for the blood were located at the bottom end of the filter assembly, and wherein a gas vent was present at the top of the filter assembly. The prior art reference taught a liquid strainer for removing dirt and water from gasoline and other light oils wherein the inlet and outlet were at the top of the device, and wherein a pet-cock (stopcock) was located at the bottom of the device for periodically removing the collected dirt and water. The reference further taught that the separation is assisted by gravity. The Board concluded the claims were prima facie obvious, reasoning that it would have been obvious to turn the reference device upside down. The court reversed, finding that if the prior art device was turned upside down it would be inoperable for its intended purpose because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of the purified gasoline, and the screen would become clogged.).

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"Although statements limiting the function or capability of a prior art device require fair consideration, simplicity of the prior art is rarely a characteristic that weighs against obviousness of a more complicated device with added function." *In re Dance*, 160 F.3d 1339, 1344, 48 USPQ2d 1635, 1638 (Fed. Cir. 1998) (Court held that claimed catheter for removing obstruction in blood vessels would have been obvious in view of a first reference which taught all of the claimed elements except for a "means for recovering fluid and debris" in combination with a second reference describing a catheter including that means. The court agreed that the first reference, which stressed simplicity of structure and taught emulsification of the debris, did not teach away from the addition of a channel for the recovery of the debris.).

One of the proposed modifications to Bier (described specifically for independent claim 25 and in roughly related manners for independent claims 36, 46, 55, and 56) is the limitation from Dooley of "a means for analyzing the Web site code, wherein the means for analyzing the Web site code comprises a means for checking for a known factor in the Web site code used by a plurality of search engines in ranking a plurality of Web sites for registration ([0056], lines 36-46, Dooley)."

(OA, page 3) The result of such an analysis of Web site code would necessarily reflect whether the Web site code had a known factor used by search engines in ranking Web sites.

On the other hand, the primary reference, Bier, is used to disclose the limitation of "a means for causing the Web site code to be edited based on a result from the means for analyzing the Web site code ([0081], Bier)" (emphasis added) (OA, page 4). The problem is that if the means for editing (from Bier) are "based on" the "means for checking for a known factor . . . used by search engines in ranking . . . Web sites" (from Dooley), Bier would not be able to automatically make group-writable Web pages ([0008], Bier), its intended purpose. Stated another way, there is no way Bier could automatically make group-writable Web pages if its method of modifying Web site code was based on an analysis looking for known factors used by search engines in ranking Web sites. Thus, the proposed modifications to Bier would render Bier unsatisfactory for its intended purpose.

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## **II. BIER, DOOLEY AND FEELEY DO NOT TEACH OR SUGGEST ALL THE CLAIM LIMITATIONS OF INDEPENDENT CLAIMS 25, 36, 46, 55, AND 56**

### **MPEP 2143.03 All Claim Limitations Must Be Taught or Suggested**

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicant respectfully submits that Bier, Dooley and Feeley do not teach or suggest all of the claimed limitations. Thus, all pending claims are patentable over the cited prior art under § 103.

### **INDEPENDENT CLAIM 25**

#### **A. Bier does not disclose a program for increasing traffic flow to a Web site**

The OA on page 3 first paragraph states:

Regarding Claim 25, Bier discloses a program for increasing traffic flow to a Web site, comprising:

Applicant respectfully disagrees. The OA does not provide a citation in Bier for this assertion. Bier at [0008] summarizes the invention as "a server-based software tool that allows group-writable web pages to be created and customized". Bier's teachings do not teach or suggest a method of "increasing traffic flow to a Web site". Thus, this part of the preamble is not taught or suggested by Bier as stated in the OA, page 3.

#### **B. Dooley does not disclose a program means for receiving a list of search engines**

The OA on page 3 states:



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On the other hand, Dooley discloses a means for receiving a list of one or more search engines to submit the Web site to for registration ([0056], lines 27-46, Dooley)<sup>1</sup>."

Applicant respectfully disagrees. Dooley discloses the existence of a plurality of well known search engines and the desirability of registering a Website with search engines. However, the claim limitation includes the language of a "program" comprising "a means for receiving a list of one or more search engines". Dooley simply does not teach or suggest a program means for receiving a list of search engines.

**C. Neither Bier nor Dooley disclose a program means for analyzing Web site code for a known factor used by search engines**

The OA on page 3 states:

Therefore, the combination of Bier in view of Dooley, disclose a means for analyzing the Web site code, wherein the means for analyzing the Web site code comprises a means for checking for a known factor in the Web site code used by a plurality of search engines in ranking a plurality of Web sites for registration ([0056], lines 36-46, Dooley)

Dooley at [0056], lines 36-46 state:

In another embodiment, enhanced placement may be attained by the inclusion of a variety of additional software code elements (e.g., Java applets, cookies, and other elements) within the website(s) design, which may be weighed favorably by search engines. In another embodiment, enhanced and/or optimized placement within search engine results may be affected by all or a subset of the website design elements embodiments listed above (e.g., plurality of links, use of simple descriptive domain names, content with keywords, registration with search engines, embedded metatags, etc.). The plurality of these web design features may provide additional or synergistic traffic into and within the member websites of the information network.

Thus, while Dooley may teach including software code elements or design elements within the website design ([0056], Dooley) and Bier may teach detecting and parsing web page code ([0081], Bier), there is no teaching or suggestion in Dooley or Bier of a program analyzing the Web site code for a known factor used by search engines. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Thus, Applicant respectfully submits that this cobbling together

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(incompletely) of Dooley and Bier is improper as it does not consider all of the words in the claim in judging patentability as required by *In re Wilson*.

#### INDEPENDENT CLAIM 36

**A. Dooley does not teach or suggest the program receiving a list of one or more search engines**

The OA states “the program receiving a list of one or more search engines to submit the Web site to for registration” is disclosed at ([0056], lines 27-46, Dooley). Applicant respectfully disagrees. While Dooley may disclose several well known search engines ([0050], Dooley) and state “[i]n one embodiment, enhanced placement may be affected by registration of website URLs with Internet search engines or brokers on their behalf,” there is no teaching or suggestion in Dooley or Bier of a “program receiving a list” of search engines.

**B. Neither Dooley nor Bier teach or suggest a program facilitating a modification of the Web site code to increase traffic flow**

The OA states “the program facilitating a modification of the Web site code based on the analyzing of the Web site code ([0081], Bier) in order to increase a traffic flow to the Web site from at least one of the search engines on the list ([0027], Dooley.”

Bier, at the cited paragraph ([0081], Bier) discloses a “method for converting input web pages to Sparrow Web type web pages” and a method “where the web page coding is detected and revised”. Dooley, at the cited paragraph ([0027], Dooley), discloses methods, particularly through the use of hyperlinks, of increasing traffic flow from search engines.

However, neither Bier nor Dooley teach or suggest a program facilitating a modification of the Web site code to increase traffic flow to a Web site. The examiner has had to selectively take parts of Bier and Dooley to recreate this single limitation. “Where prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.” *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 5 U.S.P.Q.2d 1434 (C.A.F.C. 1988) (emphasis added). “That one can reconstruct and/or explain the theoretical mechanism by means of logic and sound scientific

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reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention." *Ex parte Levengood*, 28 U.S.P.Q. 2d 1300 (P.T.O.B.A&I. 1993) (emphasis added).

Applicant respectfully submits that the fact that it takes two references to cobble together (incompletely) a single limitation is strong evidence that the invention is not made obvious by the references.

**C. Neither Bier nor Dooley teach or suggest the program submitting the Web site for registration**

The OA at page 6 states "the program submitting the Web site for registration, having the modified Web site code ([0192], Bier), to the one or more search engines ([0050], lines 12-18, Dooley)." The OA does not provide a cite in either Bier or Dooley for the first portion of the limitation, specifically "the program submitting the Web site for registration." To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Since the cited references do not disclose a "program submitting the Web site for registration," the rejection should be withdrawn and the claim allowed.

**INDEPENDENT CLAIMS 46, 55, AND 56**

**A. Dooley does not teach or suggest the program receiving a list of one or more search engines to submit the Web site to for registration**

The OA on page 9 states "the program receiving a list of one or more search engines to submit the Web site to for registration" is disclosed at ([0056], lines 27-46, Dooley). Applicant respectfully disagrees. While Dooley may disclose several well known search engines ([0050], Dooley) and state "[i]n one embodiment, enhanced placement may be affected by registration of website URLs with Internet search engines or brokers on their behalf", there is no teaching or



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suggestion in Dooley, Bier or Feeley of a program receiving a list of search engines to submit a Web site to for registration.

**B. Dooley does not teach or suggest a program analyzing the Web site code using the determining ranking methodology**

The OA on page 9 states "the program analyzing the Web site code using the determined ranking methodology ([0056], lines 36-46, Dooley)." Dooley ([0056], lines 36-46) states:

In another embodiment, enhanced placement may be attained by the inclusion of a variety of additional software code elements (e.g., Java applets, cookies, and other elements) within the website(s) design, which may be weighted favorably by search engines. In another embodiment, enhanced and/or optimized placement within search engine results may be affected by all or a subset of the website design element embodiments listed above (e.g., plurality of links, use of simple descriptive domain names, content with keywords, registration with search engines, embedded metatags, etc.). The plurality of these web design features may provide additional or synergistic traffic into and within the member websites of the information network.

Thus, while Dooley may teach including software code elements or design elements within the website design ([0056], Dooley) and Bier may teach detecting and parsing web page code ([0081], Bier), there is no teaching or suggestion in Dooley or Bier of a program analyzing the Web site code using the determined ranking methodology. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Thus, Applicant respectfully submits that using Dooley as a reference for this limitation is improper as Dooley does not teach or suggest all of the words in the claim as required by *In re Wilson*.

**C. Bier does not teach or suggest a program facilitating a modification of the Web site code to increase an expected traffic flow to the Web site**

The OA on page 9 states "the program facilitating a modification of the Web site code based on the analyzing the Web site code ([0081], Bier) to increase an expected traffic flow to the Web site from the search engine ([0027], Dooley)."

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Bier, at the cited paragraph ([0081], Bier) discloses a "method for converting input web pages to Sparrow Web type web pages" and a method "where the web page coding is detected and revised." Dooley, at the cited paragraph ([0027], Dooley), discloses methods, particularly through the use of hyperlinks, of increasing traffic flow from search engines.

However, neither Bier nor Dooley teach or suggest a program facilitating a modification of the Web site code to increase traffic flow to a Web site. The examiner has had to selectively take parts of Bier and Dooley to recreate this single limitation. "Where prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 5 U.S.P.Q.2d 1434 (C.A.F.C. 1988) (emphasis added). "That one can reconstruct and/or explain the theoretical mechanism by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention." *Ex parte Levengood*, 28 U.S.P.Q. 2d 1300 (P.T.O.B.A&I. 1993) (emphasis added).

Applicant respectfully submits that the fact that it takes two references to cobble together (incompletely) a single limitation is strong evidence that the invention is not made obvious by the references.

**D. No teachings or suggestion for the program submitting the Web site for registration**

The OA at page 10 states "the program submitting the Web site for registration, having a modified Web site code ([0192], Bier), to the one or more search engines on the list ([0050], lines 12-18, Dooley)." The OA did not provide a paragraph in either Bier or Dooley for the first portion of the limitation of "the program submitting the Web site for registration." To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Since the cited references do not disclose a program submitting a Web site for registration, the rejection should be withdrawn and the claim allowed.

**DEPENDENT CLAIMS 26-35, 37-45, 47-54**

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If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Since independent claims 25, 36, 46, 55, and 56 are believed to be allowable, variously dependent claims 26-35, 37-45, 47-54 should also be allowed.

## CONCLUSION

All claims currently present in this application are believed allowable over all of the art of record and prompt further examination of the application and its allowance are respectfully requested. Any questions or suggestions regarding the application submitted herewith should be directed to the undersigned attorneys for Applicant at the telephone number listed below or by email to the email address listed below.

Respectfully submitted,

**The Go Daddy Group, Inc.**

Date: 2/13/2007

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